

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed April 28, 2005. Through this response, claims 1, 3, 4, 6-9, 11, 30, 40, and 46 have been amended, and claim 10 has been canceled without prejudice, waiver, or disclaimer. Reconsideration and allowance of the application and pending claims 1-9, and 11-48 are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 102(b)

A. Statement of the Rejection

Claims 1, 5-12, 30, 35-37 and 39 have been rejected under 35 U.S.C. § 102(b) as allegedly anticipated by *Goldhaber et al.* ("Goldhaber," U.S. Pat. No. 5,794,210). Applicant respectfully traverses this rejection.

B. Discussion of the Rejection

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(b).

In the present case, not every feature of the claimed invention is represented in the *Goldhaber* reference.

Independent Claim 1

Claim 1 recites (with emphasis added):

1. A server from which a sender distributes content messages to one or more receivers, comprising:
a processor;
memory;
a content packet stored in the memory, the content packet including:
message content;
a sender bank identifier; and
a plurality of values that indicate different amounts based on a manner of rendering that the sender offers to credit a receiver for rendering at least a portion of the message content, wherein the processor is configured to execute a program, the program configured to construct the content packet and distribute the content packet to the one or more receivers.

Applicant respectfully submits that *Goldhaber* does not disclose at least the emphasized claim features. For example, *Goldhaber* discloses in col. 10, lines 46-54 the following:

In FIG. 3, the information 56 being provided to the consumer represents an advertisement for other such "negatively priced information." A virtual "price tag" 58 associated with information 56 indicates the amount the information provider will compensate a consumer to pay attention to the information 56. In this example, the consumer uses her computer 104 to read information 56 (and, in some embodiments, to interact with the information thereby evidencing that she has paid attention to it). In response to paying attention to the information 56, the information provider compensates the consumer...

As described, the system in *Goldhaber* provides a single value, and any additional actions are simply evidence of the consumer's attention to the ad that does not warrant additional value. Since *Goldhaber* does not disclose the emphasized claim features, Applicant respectfully requests that the rejection to independent claim 1 be withdrawn.

Because independent claim 1 is allowable over *Goldhaber*, dependent claims 2-9 and 11-12 are allowable as a matter of law for at least the reason that the dependent claims 2-9 and 11-12 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Independent Claim 30

Claim 30 recites (with emphasis added):

30. A method for distributing content messages to one or more receivers, comprising:

assembling a content packet at a computer device, the content packet including a content message and ***a plurality of rendering values***;

sending the content packet to one or more receivers;

receiving notice that a receiver has rendered a content message from the content packet;

crediting the receiver that rendered the content message with an amount equal to at least one of the plurality of rendering values based on the manner of rendering.

Applicant respectfully submits that *Goldhaber* does not disclose at least the emphasized claim features. As described above in association with independent claim 1, the system in *Goldhaber* provides a single value, and any additional actions are simply evidence of the consumer's attention to the ad that does not warrant additional value. Since *Goldhaber* does not disclose the emphasized claim features, Applicant respectfully requests that the rejection to independent claim 30 be withdrawn.

Because independent claim 30 is allowable over *Goldhaber*, dependent claims 31-39 are allowable as a matter of law.

Due to the shortcomings of the *Goldhaber* reference described in the foregoing, Applicant respectfully asserts that *Goldhaber* does not anticipate Applicant's claims 1, 2-9, 11-12, and 30-39. Therefore, Applicant respectfully requests that the rejection of these claims be withdrawn.

II. Claim Rejections - 35 U.S.C. § 103(a)

A. Statement of the Rejection

Claims 3, 4, 13-29, 32-34, 39 and 40-48 have been rejected under 35 U.S.C. § 103(a) as allegedly anticipated by *Goldhaber*. Claims 2 and 31 have been rejected under 35 U.S.C. §

103(a) as allegedly anticipated by *Goldhaber* in view of *Dedrick* (“*Dedrick*,” U.S. Pat. 5,768,521). Applicant respectfully traverses these rejections.

B. Discussion of the Rejection

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant’s disclosure.

Applicant respectfully submits that a *prima facie* case for obviousness has not been established.

Independent Claim 13

Claim 13 recites (with emphasis added):

13. (Original) An e-mail program stored on one or more computer readable media, comprising:

a receiver module configured to receive a content packet from one or more senders, the content packet including a content message, an advertiser bank account identifier, a value that the sender is willing to pay to render the content message, and finishing instructions detailing how the content message is to be rendered;

a bank request module configured to verify that an advertiser bank account identified by the advertiser bank account identifier in the content packet can satisfy the value identified in the content packet;

a rules module containing payments required to render the content message;

a rendering module configured to render the content message if the value meets or exceeds a value established in the rules module and if the bank request module verifies sufficient funds in the advertiser bank account to pay the value included in the content packet; and

a certification module configured to confirm that the content message has been rendered and to send a certification to the advertiser bank that the content message has been rendered.

Applicant respectfully submits that *Goldhaber* does not disclose, teach, or suggest at least the emphasized claim features. The Office Action makes the following assertions, among others, on page 6:

Claims 13, 22, 24, 40, 43, and 45: Goldhaber discloses a method, apparatus, and computer program for presenting content packages to a user, comprising...

e. Verifying the bank account id and the funds therein (col. 7, lines 48-61);...

While Goldhaber does not explicitly disclose that the user will preset a desired value level for the display value and that the computer program will only display messages with values which meet or exceed that level, it is disclosed that the user presets a number of criteria for the selection of which messages will be selected and displayed when the user is registering with the system. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the user to also set a minimum limit on the value of the message the user is willing to accept. One would have been motivated to have the user in Goldhaber set such a minimum value level in order to increase the worth of Goldhaber's invention to the user eliminating low value messages, thus increasing the user's satisfaction with the system.

Applicant respectfully disagrees that the verifying feature is shown or that the rendering module functionality is obvious. With regard to the section (col. 7, lines 48-61) allegedly teaching the bank account verification features, *Goldhaber* provides as follows:

Next to some of the titles on the ad list displayed to Cynthia is the image of a little gold coin--a "consumer interface button" or "CyberCoin"--with a distinctive style. When Cynthia clicks her mouse on the CyberCoin, it opens up the ad and simultaneously causes a transfer of cash or credit

directly to Cynthia's desktop (or to a specialized account, credit card or bank account associated with her). This gives Cynthia an important incentive to watch the ad. The ad can include some degree of interactivity (e.g., Forty-Niners game stadium seating preference, choice of diet dessert, etc.) to allow the service to give the advertiser a guarantee that Cynthia paid attention to the ad. This interactivity can make the ad more fun (e.g., by providing a guessing game, quiz or joke).

Nothing in this section discloses, teaches, or suggests *a bank request module configured to verify that an advertiser bank account identified by the advertiser bank account identifier in the content packet can satisfy the value identified in the content packet.*

With regard to the rendering module feature, Applicant agrees that *Goldhaber* does not explicitly disclose the preset functionality. However, nothing in *Goldhaber* would suggest that criteria entered by a user at registration has anything to do with the value a recipient can receive.

Further, col. 5, lines 26-29 asserts the following:

Since all the ads on the list will be targeted to the consumer's needs, interests, and preferences, it is very likely that she would be inclined to view them even without a cash incentive.

This assertion in *Goldhaber* would suggest just the opposite of what is being claimed. That is, since the ads appear to be targeted in *Goldhaber*, any compensation would be desired and certainly not conditional on any preset limits. Given that *Goldhaber* does not disclose, teach, or suggest the emphasized claim features, Applicant respectfully submits that independent claim 13 is patentable over *Goldhaber* and respectfully requests that the rejection to independent claim 13 be withdrawn.

Because independent claim 13 is allowable over *Goldhaber*, dependent claims 14-21 are allowable as a matter of law.

Independent Claim 22

Claim 22 recites (with emphasis added):

22. A printer, comprising:

an e-mail module configured to receive an e-mail message from one or more senders, said e-mail message containing a content packet that includes a content message that is printable on the printer and a print value that identifies a value the sender is willing to pay to print the content message;

a rules module that contains a value required to print the content message *and that is configured to print the content message if the print value is greater than or equal to the value in the rules module;*

a print confirmation module configured to verify that the content message was printed; and

a notice module configured to notify the sender that the content message was printed on the printer.

Applicant respectfully submits that *Goldhaber* does not disclose, teach, or suggest at least the emphasized claim features. Applicant notes that a *printer* is not even mentioned in *Goldhaber*. Not surprisingly, *Goldhaber* also does not disclose, teach, or suggest *a print confirmation module configured to verify that the content message was printed* or *a notice module configured to notify the sender that the content message was printed on the printer*, as recited in independent claim 22.

With regard to the print value feature, nothing in *Goldhaber* would suggest that criteria entered by a user at registration has anything to do with the value a recipient can receive. As discussed above in association with independent claim 13, col. 5, lines 26-29 of *Goldhaber* suggests that any compensation would be desired and certainly not conditional on being greater than or equal to some value. Given that *Goldhaber* does not disclose, teach, or suggest the emphasized claim features, Applicant respectfully submits that independent claim 22 is patentable over *Goldhaber* and respectfully requests that the rejection to independent claim 22 be withdrawn.

Because independent claim 22 is allowable over *Goldhaber*, dependent claims 23-29 are allowable as a matter of law.

Independent Claim 40

Claim 40 recites (with emphasis added):

40. A method for receiving content messages from one or more sender computer devices, comprising:

- receiving a content packet from a sender computer device, the content packet containing a content message and a rendering value, the rendering value indicating an amount the sender computer device offers to credit for rendering the content message;

- automatically initiating rendering of the content message if the rendering value is greater than or equal to a pre-determined rendering limit;*

- notifying the sender computer device that the content message has been rendered; and

- sending credit instructions to the sender computer device to receive credit for the rendering value.

Applicant respectfully submits that *Goldhaber* does not disclose, teach, or suggest at least the emphasized claim features. With regard to the rendering value feature, nothing in *Goldhaber* would suggest that criteria entered by a user at registration has anything to do with the value a recipient can receive. As discussed above in association with independent claim 13, col. 5, lines 26-29 of *Goldhaber* suggests that any compensation would be desired and certainly not conditional on being greater than or equal to some value. Given that *Goldhaber* does not disclose, teach, or suggest the emphasized claim features, Applicant respectfully submits that independent claim 40 is patentable over *Goldhaber* and respectfully requests that the rejection to independent claim 40 be withdrawn.

Because independent claim 40 is allowable over *Goldhaber*, dependent claims 41-48 are allowable as a matter of law.

Claims 2 and 31

Applicant respectfully submits that the proposed combination of *Goldhaber* and *Dedrick* does not disclose, teach, or suggest the features of claims 2 and 31. As described above, *Goldhaber* does not disclose, teach, or suggest the features of independent claims 1 and 30. *Dedrick* does not remedy the deficiencies of *Goldhaber*. Thus, independent claims 1 and 30 are allowable over the combination of *Goldhaber* and *Dedrick*. Since dependent claims 2 and 31 contain the features of their respective base claims 1 and 30, Applicant respectfully submits that claims 2 and 31 are allowable over the combination of *Goldhaber* and *Dedrick* as a matter of law. Thus, Applicant respectfully requests that the rejection to claims 2 and 31 be withdrawn.

Assertions of Well Known Art

The Office Action makes the following statements of well-known art:

(Page 7 and Page 8) The Examiner notes that the disclosed interacting with the message by the user would encompass all types of interactions to include viewing, clicking on, printing, playing, listening to, or downloading and storing the message. These are well known types of interactions between a user and information being displayed on the user's computer. It is also well known for an advertiser to pay a first amount when a user is initially displayed an advertisement, and then pay a second amount if the user interacts with the advertisement in one of the above mentioned ways.

Applicant respectfully traverse this finding of well-known art and submits that the subject matter noted above should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support the conclusions, as required. The Manual of Patent Examining Procedure (MPEP) defines the standard for taking official notice. As provided in MPEP § 2144.03:

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be

taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424, F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be “capable of such instant and unquestionable demonstration as to defy dispute” (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

As provided in MPEP § 2144.03 (emphasis added):

If applicant adequately traverses the examiner’s assertion of official notice, *the examiner must provide documentary evidence in the next Office action* if the rejection is to be maintained. See 37 CFR 1.104(c)(2).

Accordingly, Applicant traverses the Examiner’s use of official notice. Because of this traversal, the Examiner must support his finding with evidence, or withdraw the official notice determination.

Improper Rejection

Applicant respectfully submits that the rejection to claims 20 and 21 are improper. The Office Action alleges (on page 9) the following:

While it is not explicitly disclosed that the computer program is running on a printer, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the user device could include a printer, if the printer had the required computing capability, or if a computer has a built-in printing capability. The Examiner notes that the line between a computer with printing capabilities and a printer with computing capabilities is very fine and is quickly becoming non-existent with the emergency of multiple-use devices.

Applicant respectfully notes that the rejection fails to disclose a motivation, and thus the rejection necessarily fails. Further, it is unclear how the alleged state of the art today is relevant to the claims at the time of the invention. Thus, Applicant respectfully requests that the rejection be withdrawn.

In summary, it is Applicant's position that a *prima facie* for obviousness has not been made against Applicant's claims. Therefore, it is respectfully submitted that each of these claims is patentable over *Goldhaber* and *Dedrick* and that the rejection of these claims should be withdrawn.


III. Canceled Claims

As identified above, claim 10 has been canceled from the application through this Response without prejudice, waiver, or disclaimer. Applicant reserves the right to present these canceled claims, or variants thereof, in continuing applications to be filed subsequently.

CONCLUSION

Applicants respectfully submit that Applicants' pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, and similarly interpreted statements, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



David Rodack
Registration No. 47,034